




0324.63920

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Marc S. Cohen
Serial No.: 09/590,489
Conf. No.: 2507
Filed: June 6, 2000
For: MESSAGING AND PROMOTION
FOR DIGITAL AUDIO MEDIA
PLAYERS
Art Unit: 2685
Examiner: Chow, Charles Chiang

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

10/25/05 
Date Registration No. 35132
F-CLASS.WCM
Appr. February 20, 1998 Attorney for
Applicant(s)

Pre-Appeal Brief Request for Review

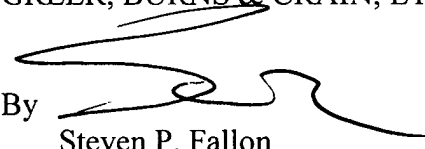
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Dear Sir:

Applicant requests a pre-appeal review of the outstanding final rejections of the pending claims in this application based upon the attached remarks.'

Respectfully submitted,

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By 
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October 24, 2005

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Pre-Appeal Brief Request for Review
Remarks

An inadequate examination is demonstrated by the record of this prosecution and, in particular, unsupported misrepresentations of the applied prior art that can only be based upon a careless or cursory review of the applied prior art and application. No genuine factual dispute is shown in the record. Motivations are unsupported. Requirements of the law of obviousness are not met.

Fairness dictates that the rejections be withdrawn and the application allowed without subjecting applicant to the delay and expense of a full appeal in a case that has already had a five-year pendency.

I. The Application Should be Allowed on Pre-Appeal Because the Rejections Involve Misrepresenting the Art, and No Genuine Factual Dispute is Raised by the Unsupported Allegations Concerning the Content of the Applied References

The record is littered with inaccurate explanations of the art that do not show a factual dispute. Instead, they show an intentional distortion of the references to fit the theory of rejection, which has clearly been pre-ordained during this examination. Misstatements cited here are examples showing that there has not been an objective interpretation of the art.

A. The Assertion that Hunter Teaches Playing Messages in Response to a Playback Operation as Required by Claims 1, 14, 21 and 22 is Not Supported by the Reference

Statements on pages 3, 4, 6 and 7 of the final action allege "The user can playback the downloaded stored promotional message from the preview operation (Fig. 2, col. 3, lines 52-55; upper right corner of Fig. 10)." To the contrary, column 13, lines 36-43 of Hunter state quite clearly that the system displays an advertisement based on customer profiles, not in response to a playback operation: "Along with music, there is blanket transmission of catalogs and other advertising or customer interest information. The storage and display of this information may be based on customer profiles." Col. 13, lines 34-37.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. The prior art does not teach, nor in

any way suggest, playing a message in response to a playback operation of the digital audio media player.

B. The Assertion that that Hazenfield Teaches the Distribution of Portable Digital Audio Media Players as Required by Claim 14 is Not Supported by the Reference

Page 4 of the final action asserts that: “Hazenfield teaches... the method comprising steps of arranging the distribution of portable digital audio media players.” A quick review of the fig. 2 in Hazenfield will show Hazenfield is concerned with a (“music on hold”) MOH system. The system includes, as seen in FIG. 2, a disk carousel, a public address system, etc. and is anything but portable. From the first line of the background, Hazenfield makes clear that the MOH system is for use with the telephone system of a business. C1, L16 et seq.

C. The Assertion that Hazenfield Teaches Distributing Digital Audio Media Players with Promotion Indicia as Required by Claim 16 is Not Supported by the Reference

Page 5 of the final action asserts that Hazenfield teaches the distribution and marking of players. The alleged support for this assertion is the following statement in Hazenfield – “the 50% saving and extended business hours, col. 5, line 11-17”. This statement refers clearly to the content of the messages of Hazenfield, and not to the marking of any equipment used to play messages in Hazenfield (which lacks any portable players of any kind as mentioned above). As seen in the cited paragraph in column 5, this concerns “announcing 30% savings during the sale event” of “50% savings and extended business hours”. C5, L 1-17.

D. The Assertion That Hazenfield Teaches Messages that Promote Music as Required by Claim 17 is Not Supported by the Reference

Page 5 of the final action asserts that Hazenfield teaches messages that promote music and cites column 3, lines 49-55. However, this section of Hazenfield states only that the word “message” is a generic term that includes music that may be played on the MOH system; there is no mention or suggestion of promoting music. In the cited portion of the reference, “music can be played . . . for a person whose telephone call has been answered.”

E. Nothing Supports Assertions that Benjamin Teaches the Playback of Messages Defined in Claim 1 in Response to a Track End as Required by Claim 2

Page 7 of the final Office action refers to a figure in this patent that describes playing the next track of a playlist after the prior track ends. This sequence is fundamental to playing compact discs and has been known since the late 1970s when CDs were developed. Benjamin does not teach anything about playing messages that are not included as a track on a playlist, like the messages described in the present application. Column 12 lines 24-29, however, clearly describe that “messages” are merely control instructions sent between internal components of the digital audio media player. *Id.* Benjamin’s messages are as similar to the claimed “promotional, informational or instructional messages” (claims 1, 14, 21, and 22) messages of our application as lightning is to lightning bug.

II. The Application Should be Allowed on Pre-Appeal Because the Law of Obviousness is Not Followed in the Final Rejection, as Indicated by the Changing Bases for Rejection and the Use of Art From Different Fields that Does Not Show a Motivation to Combine

A. While the Art Used Has Changed, the Claims Continue to Be Rejected, Indicating a Pre-Disposition for Rejection and the Use of Hindsight, With References from Far Afield and Directed to Different Problems

Applicant has suffered through shifting bases for rejection that indicate a pre-disposition to reject the pending claims, with liberal use of impermissible conjecture and hindsight. In the second office action claims 14-18 are rejected, after first being indicated allowable. In the third office action, subsequent to an interview, the prior art used to reject all 23 claims is changed. On May 23, 2005 the Examiner participated in a telephone interview with the undersigned attorney. During the course of this interview amendments were agreed upon to place the case in a condition for allowance. The amendments were made not because applicant believe that the rejections had an adequate foundation, but because the terms added to the claims did not change the scope of the claims, but merely added the specification’s definition of “messages” as to the claims. Applicant made the amendments to expedite prosecution, as the rejections were inadequate. This agreement, like the changing rejections had a short lifetime. After the amendments, new assertions of obviousness, supposedly necessitated by the amendments, were made by the examiner.

In the end, the opinion of obviousness remained the same, while different references were used to support the pre-ordained conclusion. Still, none of the stated bases for motivation has support in the prior art.

The final office action states "...both Hunter and Hazenfield are in the similar field for music distribution" (final Office action page 14). This is an overly broad statement of the field, because, for example, popular music distribution is different than music distribution for supermarket and telephone on-hold systems. However, even the overly broad statement of an imaginary field to link the references with each other and the claimed invention fails. The invention integrates updateable messages with the recorded audio files (e.g. music) a user already possesses. The invention concerns providing messaging to be used with music that has *already been distributed*, prior to the role of the invention, and it indubitably follows that the invention is not in the field of music distribution.

Nor is the prior art pertinent to the problem solved by the invention. Hazenfield concerns messages that are fixed by recording onto CDs that are delivered by some mechanical means. These messages are used in the telephone MOH system. As is made clear in column 4 at line 41, "each message playback device 24 is preferably provided with a compact disk (CD) or disks 35 on which messages have been recorded." There is also an alternative discussed, but it has nothing to do with broadcast over a wireless medium. The alternative is stated as "messages, however, can also be stored and distributed on other storage media such as an integrated circuit or a magnetic disk."

On page 4, lines 12-14 of the instant application, it is explicitly stated that the fixing of messages on a physical memory medium prior to delivery, such as taught by Hazenfield, is an unsatisfactory solution to the problem of integrating updateable messages with recorded audio files.

B. No Proper Motivation for Combining the References has Been Established.

Regarding the motivation to combine the references to reject claims 1, 14, 21 and 22, the statement of motivation is that: "Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to modify Hazenfield with Hunter's

advertisement with music, in order to sale (sic) more music, with the advertisement in previewing.”

This statement misses an essential point: the issue is not whether the person of ordinary skill in the art had the skill to combine known teachings to make the invention of the application, but instead, whether the applied prior art provides such a person with any suggestion or motivation to do so.

Neither the references, nor the art in general, support the alleged motivation, however. Hazenfield is concerned with telephone on-hold systems. Hunter, in complete contrast, concerns a music distribution system that makes use of satellite TV set top boxes and the geostationary satellite used by Hughes and Echostar. This is discussed in column 6, lines 30-51. The references have little to do with each other, and have even less relevance to the present invention as claimed. No motivation to combine can be found from an unguided reading of the references themselves.

The Examiner fails to clarify the prior art and show, in a clear and particular manner, that any motivation to combine is present in these references. The Examiner’s oft-repeated, three-line statement of motivation is not even close to clear; rather, it is well-nigh incomprehensible, and has no basis in the art of record.

III. Conclusion

Applicant asks that this pre-appeal review request be sustained, and the application allowed. As no sufficient rejections have been established, the five-year pendency of this application should be ended with the issuance of notice of allowance.

Respectfully submitted,

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